

REMARKS

1. Claim Rejections – 35 U.S.C. § 103(a)

The Examiner has rejected claims 1-138 under 35 U.S.C. § 103(a) as being unpatentable over Raven et al in view of Hirsch. Applicants respectfully traverse this rejection. For the sake of brevity, the rejections of the independent claims are discussed in detail on the understanding that the dependent claims are also patentably distinct over the cited references, as they depend directly from their respective independent claims. Nevertheless, the dependent claims include additional features that, in combination with those of the independent claims, provide further, separate and independent bases for patentability.

The Examiner makes a conclusory statement that “integrating game-play and service systems is well-known.” It appears that the Examiner is paraphrasing the claimed elements of “*a systems interface [that is] incorporated into the gaming interface display screen of the gaming platform, wherein the systems interface displays non-gaming system information from a system network through the gaming platform to a casino player or employee via the gaming interface display screen of the gaming platform*” “*wherein the systems interface utilizes the gaming platform to produce enhanced system request capabilities with enhanced graphics and animation for enabling interactions with the system network.*” Applicants submit that the Examiner has not provided any supporting references which teach or suggest that the above-claimed elements are well-known.

Applicants respectfully refer the Examiner to MPEP §2144.03B, which requires a technical line of reasoning when relying on “common knowledge.” More specifically, “there must be some form of evidence to support an assertion of common knowledge. See *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001) (holding that general conclusions concerning what is “basic knowledge” or “common sense” to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection).

Continuing, the Examiner’s assertion that the above-claimed element was well known at the time the invention was made, is completely unsupported by the art of record. Accordingly,

Applicants respectfully traverse this assertion by the Examiner and formally request that the Examiner provide reference(s) in support of this assertion. Otherwise, an Examiner cannot maintain a rejection based on his own opinion as to what is common knowledge and well known in an art without any supporting references, after the Applicants have challenged the Examiner's assertion. MPEP. § 2144.03.

Specifically, none of cited references teach or suggest the claimed elements of *"a systems interface [that is] incorporated into the gaming interface display screen of the gaming platform, wherein the systems interface displays non-gaming system information from a system network through the gaming platform to a casino player or employee via the gaming interface display screen of the gaming platform"* *"wherein the systems interface utilizes the gaming platform to produce enhanced system request capabilities with enhanced graphics and animation for enabling interactions with the system network."* These capabilities are made possible by the unique abilities derived from the gaming platform used in conjunction with the systems interface. In the cited references, all of the identified systems interfaces (i.e., devices for interfacing with a system network to access "non-gaming" system-type functions) have not been incorporated into the gaming platform of a gaming device. As a result, these systems interfaces have not been able to produce (1) enhanced system request capabilities and (2) enhanced graphics and animation for enabling interactions with the system network. These are clear limitations of the cited references that have been overcome by the claimed invention.

The Examiner has relied on the Raven et al. reference and the Hirsch et al. reference. The Raven et al. reference discloses external system (non-gaming) components such as an external 2-line VF display and an external keypad shown with limited capabilities due, at least in part, to their separation from the gaming platform. This limitation is overcome by the architecture of the claimed invention. The Hirsch reference is cited by the Examiner for disclosing the capacity to display multiple graphical images in the game animations. Respectfully, it appears that the Examiner may be overlooking the claimed capability to produce (1) enhanced system (non-gaming) request capabilities and (2) enhanced graphics and animation for enabling interactions with the system (non-gaming) network.

The Examiner has taken the position that it would be obvious to integrate gaming and system services into a single display system. The Examiner has cited MPEP § 2144.04 as well as the case of *In re Larson*, 340 F.2d 965, 968; 144 USPQ 347, 349 (CCPA 1965), in support of this “obvious to integrate” position.

MPEP § 2144.04 Does Not Allow The Use Of Case Law To Support An Obviousness Rejection Once The Criticality Of A Specific Limitation Has Been Demonstrated

Applicants respectfully point out **MPEP 2144.04** Legal Precedent as Source of Supporting Rationale, which states: “As discussed in MPEP § 2144, if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court. ... If the applicant has demonstrated the criticality of a specific limitation, it would not be appropriate to rely solely on case law as the rationale to support an obviousness rejection.” (emphasis added).

Therefore, once the Applicants have demonstrated the criticality of a specific limitation, it is no longer permissible for an Examiner to rely solely on examples in case law (which are listed in MPEP § 2144.04) to support an obviousness rejection. Accordingly, since the Applicants have explained how the claim limitation of the systems interface utilizing the gaming platform to produce “*enhanced system request capabilities with enhanced graphics and animation for enabling interactions with the system network*,” the Examiner can no longer rely on *In re Larson*, as sole support for his “obvious to integrate” position.

Accordingly, Applicants respectfully submit that MPEP § 2144.04 supports the Applicants’ position, and that the 35 U.S.C. § 103(a) rejection of claims 1-138 as unpatentable over Raven et al. has been overcome.

The Facts Of *Schenck V. Nortron Corp.*, In Which The Court Found The Claims To Be Patentable, Are More Analogous To The Current Situation Than The Facts Of *In Re Larson*

Referring now to **MPEP § 2144.04 (V)(B)**, in the case of *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983), the claims were directed to a vibratory testing machine (a hard-bearing wheel balancer). The vibratory testing machine included a holding structure, a base structure, and a supporting means that form “a single integral and gapless

continuous piece.” The opponent of the patentee argued that the patentee’s invention just made integral what had been previously made in four bolted pieces. However, the court found this argument unpersuasive and held that the claims were patentable because the prior art perceived a need for mechanisms to dampen resonance. The inventor eliminated the need for dampening via the one-piece gapless support structure, showing insight that was contrary to the understandings and expectations of the art.

As such, Applicants posit that *Schenck v. Nortron Corp.* is far more relevant than *In re Larson*, in which “a brake drum integral with clamping means” was found not to be patentably distinct from the prior art, where a brake disc and clamp were comprised of several parts but rigidly secured together as a single unit. In the case of *In re Larson*, there was no perceived benefit of rigidly securing several parts into a single unit; and thus, there was no patentability distinct invention. However, in *Schenck v. Nortron Corp.*, there was a benefit to combining the supporting means into “a single integral and gapless continuous piece.” That benefit was the elimination of the need for a dampening system. In the claimed invention of the present application, the incorporation of a systems interface into the display screen of the gaming platform, and the utilization of the gaming platform by the systems interface, results in the benefits of (1) enhanced system request capabilities and (2) enabling interactions with the system network that are not limited to discrete keypad type inputs for system requests. Therefore, the claimed invention of the present application clearly shows a distinct benefit, as did the claimed invention in *Schenck v. Nortron Corp.*, and thus, the claimed invention of the present application is patentability distinct over the prior art.

Accordingly, Applicants respectfully submit that MPEP § 2144.04 (V)(B) supports the Applicants’ position, and that the 35 U.S.C. § 103(a) rejection of claims 1-138 as unpatentable over Raven et al. has been overcome.

According to MPEP § 2144.04 (II)(B), Omission of an Element with Retention of the Element’s Function Is an Indicia of Unobviousness

Applicants note that MPEP § 2144.04 (II)(B) clearly states that the omission of an element and retention of its function is an indicia of unobviousness. Referring now to MPEP § 2144.04 (II)(B), in the case of *In re Edge*, 359 F.2d 896, 149 USPQ 556 (CCPA 1966), the

claims at issue were directed to a printed sheet having a thin layer of erasable metal bonded directly to the sheet. The thin layer obscured the original print until it was removed by erasure. The prior art disclosed a similar printed sheet that also included an intermediate transparent layer and erasure-proof protecting layer that prevented erasure of the printing when the top layer was erased. The claims were found to be unobvious over the prior art because (1) the transparent layer in the prior art was eliminated, and (2) the function of the transparent layer was retained (since appellant's metal layer could be erased without erasing the printed indicia.).

Analogously, in the claimed invention of the present application, external system components (such as an external 2-line VF display and an external keypad shown in the Raven et al. reference) have been eliminated, while their functions have been retained. Indeed, as discussed in Section 2 above, not only have their functions been retained, their functions have been enhanced. Using the claimed invention, the system network is able to send system information, in an enhanced format, to a player or employee through the gaming platform to the systems interface, which is in the display screen of the gaming device itself. As a result, the need for the external 2-line VF display has been eliminated, while associated functionality has not only been maintained, it has actually been enhanced. In a similar manner, incorporating the systems interface (1) into the display screen and (2) through the gaming platform has eliminated the need for the external keypad, while its associated functionality has not only been maintained, it has actually been enhanced.

Accordingly, Applicants respectfully submit that MPEP § 2144.04 (II)(B) supports the Applicants' position, and that the 35 U.S.C. § 103(a) rejection of claims 1-138 as unpatentable over Raven et al. has been overcome.

The Examiner has impermissibly used hindsight to render the invention obvious. It is a well-settled principle that "one cannot use hindsight to construction to pick and choose among isolated disclosures to deprecate the claimed invention." In re Fritch, 23 USPQ2d 1780, 1784 (Fed. Cir. 1992). The Applicant respectfully submits that the Examiner has impermissibly used hindsight to render the present invention obvious. Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability—the essence of hindsight. In re Dembiczak, 175 F.3d 994, 999 (CAFC 1999). The range of sources available, however, does not

diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., C.R. Bard, 157 F.3d 1340, 1352, 48 USPQ2d. 1225, 1232 (Fed. Cir. 1998). "Broad conclusory statements regarding the teachings of multiple references, standing alone, are not 'evidence'" (emphasis added). In re Dembiczak, 175 F.3d at 999.

Therefore, Applicant respectfully submits that the 35 U.S.C. §103(a) rejection of claims 1-138 have been overcome.

CONCLUSION

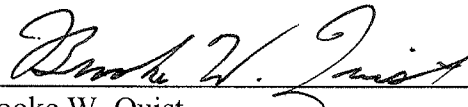
Applicants have made an earnest and *bona fide* effort to clarify the issues before the Examiner and to place this case in condition for allowance. Reconsideration and allowance of all of claims 1-138 is believed to be in order, and a timely Notice of Allowance to this effect is respectfully requested.

The Commissioner is hereby authorized to charge the fees indicated in the Fee Transmittal, any additional fee(s) or underpayment of fee(s) under 37 CFR 1.16 and 1.17, or to credit any overpayments, to Deposit Account No. 194293, Deposit Account Name STEPTOE & JOHNSON LLP.

Should the Examiner have any questions concerning the foregoing, the Examiner is invited to telephone the undersigned attorney at (310) 734-3200. The undersigned attorney can normally be reached Monday through Friday from about 9:00 AM to 6:00 PM Pacific Time.

Respectfully submitted,

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